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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,889

07/07/2004

Ralf Noerenberg

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8794

22850 7590 02/28/2007

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

MRUK, BRIAN P

ART UNIT

PAPER NUMBER

1751

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
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3 MONTHS

02/28/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/28/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/500,889

Applicant(s)

NOERENBERG ET AL.

Examiner

Brian P. Mruk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 9, 2007 has been entered.
2. This Office action is in response to Applicant's Remarks filed January 9, 2007. Claim 15 has been amended. Currently, claims 15-28 remain pending in the application.
3. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office actions, Paper Nos. 20060418 and 20061002.
4. The rejection of claims 15-28 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Evers et al, EP 616,026, is maintained for the reasons of record.

5. The rejection of claims 15-28 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Oldenhove et al, EP 620,270 is maintained for the reasons of record.

6. The rejection of claims 15-28 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,680,412 is maintained for the reasons of record.

### **NEW GROUNDS OF REJECTION**

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 15-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, for containing the phrase "having a homolog distribution specific for alkylglycol results." This phrase renders the claim vague and indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the phrase "having a homolog distribution specific for alkylglycol results". For examination purposes, the examiner will treat the

limitation "having a homolog distribution specific for alkylglycol results" as meaning any possible homolog distribution that contains the specific alkylglycol alkoxylates or alkyldiglycol alkoxylates required in instant claim 15. Appropriate correction and/or clarification is required.

10. Instant claims 16-28 are rejected under 35 U.S.C. 112, second paragraph, for being dependent upon claim 15.

#### ***Response to Arguments***

11. Applicant's arguments filed January 9, 2007 have been fully considered but they are not persuasive.

Applicant continues to argue that each of Evers et al, EP 616,026, and Oldenhove et al, EP 620,270, do not meet the requirements of the instant claims, since the references do not teach or suggest in general an alkylglycol alkoxylate or alkyldiglycol alkoxylate that is free from alcohol and contains the specific homolog distribution required in the instant claims. However, the examiner respectfully disagrees. Specifically, the examiner maintains that Evers et al clearly discloses compositions in Examples I-VIII that do not contain alcohols. Also note that Examples 1A and 1C-1G of Oldenhove et al are free from alcohols, per the requirements of the instant invention. Furthermore, with respect to the newly added limitation "having a homolog distribution specific for alkylglycol results", the examiner asserts that applicant's table from page 7 of the specification does not provide a clear definition that

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would enable a person of ordinary skill in the art to ascertain the metes and bounds of this phrase (see Paragraph No. 9 above). Specifically, the examiner maintains that the alkylglycol alkoxylates and alkyldiglycol alkoxylates disclosed in Evers et al, EP 616,026, and Oldenhove et al, EP 620,270, clearly meet the presently claimed alkylglycol alkoxylates and alkyldiglycol alkoxylates of the instant invention, since they are free from alcohol, and are obtained by the same process that is presently claimed. Furthermore, the examiner notes that page 8, lines 30-34 of the instant specification admits that the presently claimed nonionic surfactants are known and described in Evers et al, EP 616,026.

Applicant continues to argue that the instant claims are not an obvious formulation in view of claims 1-21 of U.S. Patent No. 6,680,412, since claim 7 of U.S. Patent No. 6,680,412 prepares the alcohol alkoxylates by reacting an alcohol with an alkyl alkylene oxide. However, the examiner respectfully maintains that claims 1-6 of U.S. Patent No. 6,680,412 discloses an alcohol alkoxylate of formula (I) that does not contain an alcohol, as required in the instant claims.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00AM-5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BPM

Brian P Mruk  
February 15, 2007

*Brian P. Mruk*

Brian P Mruk  
Primary Examiner  
Art Unit 1751